

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EBERHARD KONIG, KALR-LUDWIG NOBLE
and THEODOR ENGBERT

Appeal 2000-0115
Application 08/922,818¹

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and GARDNER-LANE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
Decision on appeal under 35 U.S.C. § 134

The appeal is from a decision of the Primary Examiner
rejecting claims 1-5. We affirm-in-part and reverse-in-part.

¹ Application for patent filed 9 September 1997. Applicants claim priority under
35 U.S.C. § 119 of German patent application 19637334.4, filed 13 September 1996. The
real party in interest is Bayer AG.

A. Findings of fact

The record supports the following findings by a preponderance of the evidence.

The invention

1. The invention described in the specification, as filed, relates to a composition comprising a blocked (cyclo)aliphatic polyisocyanate containing
 - (A) a stabilizer which is a 2,2,6,6-tetramethyl-piperidine which does not contain any hydrazide structure,
 - (B) optionally, an additional stabilizer which is a hydrazide, and
 - (C) optionally an additional stabilizer beyond stabilizers (A) and (B).

Specification, pages 2-3.

2. The composition is said to be useful as a crosslinking resin for organic polyhydroxyl compounds in the production of stoving lacquers. Specification, page 5, lines 25-27).

Prosecution history

3. Applicants originally presented claims 1-3.

4. There came a time during the prosecution when the examiner rejected claims 1 and 3 as being unpatentable under 37 U.S.C. § 102(b) over Gras, U.S. Patent 5,173,560² (Paper 4, page 2).

5. The examiner also rejected the claims 1-3 as being unpatentable under 35 U.S.C. § 103(a) over Cook, U.S. Patent 5,216,078³ or Konig, U.S. Patent 5,523,377⁴ in view of Uhrhan, U.S. Patent 4,178,279⁵ (Paper 4, pages 3-4).

6. Part of applicants' effort to overcome the anticipation rejection based on Gras involved an amendment to claim 1. Specifically, applicants amended claim 1 as follows (relevant additional limitations underscored) (Paper 8, page 2):

1. (Amended) A (cyclo)aliphatic polyisocyanate composition which has a content of blocked and unblocked isocyanate groups (calculated as NCO) of 5 to 25 wt%, in which at least 95% of the isocyanate groups are present in a form blocked with a blocking agent, which does not contain a 2,2,6,6-tetramethyl piperidiny1 group, and

² Gras is prior art vis-a-vis applicants under 35 U.S.C. § 102(b).

³ Cook is prior art vis-a-vis applicants under 35 U.S.C. § 102(b).

⁴ Konig is prior art vis-a-vis applicants under 35 U.S.C. § 102(a) and § 102(e).

⁵ Uhrhan is prior art vis-a-vis applicants under 35 U.S.C. § 102(b).

which also contains the following stabilizing compounds:

A) *** B) *** and C) ***.

7. Applicants also added claims 4 and 5 to the application.

8. In support of their amendment to claim 1, applicants made the following observation (Paper 8, pages 3-4):

Claim 1 has been amended to indicate that the blocking agent of the polyisocyanate does not contain a 2,2,6,6-tetramethyl piperidiny1 group. Support for the amendment can be found in the following sections of the specification which reasonably convey to one skilled in the art that [a]pplicants have invented a polyisocyanate that is blocked with a blocking agent that does not contain the 2,2,6,6-tetramethyl piperidiny1 group. In page 4, lines 3-6 and lines 7-13, for instance, the specification lists blocking agents [page 4] and stabilizing agents separately. The blocking agents do not contain the 2,2,6,6-tetramethyl piperidiny1 group. Support can also be found in example 1 in which a polyisocyanate is blocked with butanone oxime. As such, the amendments have been made to better define the

invention. Neither amendment introduces new matter into the application.

9. The specification, as filed, states (page 4, lines 3-6):

Examples of suitable blocking agents that may be used include butanone oxime, diisopropylamine, 1,2,4-triazole, imidazole, malonic ester, acetoacetic ester, dimethyl pyrazole, , -caprolactam, and mixtures thereof. Butanone oxime is particularly preferred.

10. Example 1 of applicants' specification, as filed, describes the use of the blocking agent butanone oxime (page 6).

11. Upon consideration of the amendment to claim 1, the examiner withdrew the anticipation rejection based on Gras and entered a final rejection of claims 1-5 under the first paragraph of 35 U.S.C. § 112 finding that applicants' specification, as filed, does not describe the invention of amended claim 1 (Paper 9, page 2).

12. The examiner also finally rejected claims 1-5 as being unpatentable for obviousness based on Cook or Konig in view of Uhrhan (Paper 9, pages 3-5).

13. A copy of claims 1-5 as finally rejected appears as an appendix to this MEMORANDUM OPINION and ORDER.

Examiner's Answer

14. In the Examiner's Answer, claims 1-4 stand rejected under the first paragraph of 35 U.S.C. § 112 as claiming subject matter not described in the specification, as filed (Paper 14, page 3). The examiner did not pursue a § 112 rejection of claim 5 in the Examiner's Answer.

15. Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cook or Konig in view of Uhrhan.

Other findings

16. Other findings appear in the discussion portion of this MEMORANDUM OPINION and ORDER.

B. Discussion

1. Prior art rejection

The examiner acknowledges that neither Cook nor Konig describe a composition containing a stabilizer (1) having a 2,2,6,6-tetramethyl piperidiny radical and (2) not having a hydrazide structure (Paper 14, page 4). However, the examiner found that the use of compounds "lacking hydrazide groups *** to stabilize polyisocyanates and prepolymers *** [were] known ***" (Paper 14, page 4). To support his finding, the examiner

relies on Uhrhan. Finding that applicants are using the Uhrhan compounds for their intended use, the examiner further found that there was motivation to use the Uhrhan compounds in place of the hydrazide group-containing compounds of Cook or Konig.

The mere fact that all of the elements of a claimed combination are found in the prior art is not per se sufficient to justify a § 103 rejection. Smith Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. The relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references, and that would also suggest a reasonable likelihood of success. Such a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved); In re Kotzab, 217 F.3d 1365, ____, 55 USPQ2d 1313, ____ (Fed. Cir. 2000) (identification in the prior art of each individual part claimed is insufficient to

defeat patentability of the whole claimed invention; rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant)

Our disagreement with the examiner in this appeal is his finding of motivation. The mere fact that an element is being used for its known purpose may not be sufficient in a particular case. In this case, Cook and Konig describe the use of hydrazide-containing stabilizers and do not give the slightest hint that a non-hydrazide-containing stabilizer could be used in place of their hydrazide-containing stabilizers. Thus, it is not apparent to us why a person of ordinary skill in the art would have been motivated to use a non-hydrazide containing stabilizer in the Cook and Konig inventions. The use of a non-hydrazide-containing stabilizer would appear to be inconsistent with the inventions described by Cook and Konig.

The decision of the examiner rejecting claims 1-5 over Cook or Konig in view of Uhrhan will be reversed.

2. The lack of written description rejection

The examiner found that applicants' specification, as filed, did not describe a polyisocyanate composition

containing isocyanate groups blocked with any blocking agent except a blocking agent containing a 2,2,6,6-tetramethyl piperidiny1 group. Accordingly, the examiner found that the subject matter of claims 1-4, as amended, define subject matter not described in the specification, as filed.

We agree-in-part and disagree-in-part.

Claim 2 depends from claim 1 and limits the blocking agent to one which comprises butanone oxime. Claim 4 depends from claim 1 and limits the blocking agent to a Markush group of butanone oxime, diisopropylamine, 1,2,4-triazole, imidazole, malonic ester, acetoacetic ester, dimethyl pyrazole and , -caprolactam. The lack of 2,2,6,6-tetramethyl piperidiny1 group limitation would not apply to the block agents of claims 2 and 4. Hence, the examiner's rejection of claims 2 and 4 based on a lack of written description cannot be sustained.

However, we agree with the examiner's findings with respect to claims 1 and 3 (with claim 3 [1] depending from claim 1 and [2] not further limiting the blocking agent). The specification, as filed, does not evidence applicants' possession of the invention of claim 1, as currently worded. Rather, on this record, it plainly appears that applicants

came into possession of the invention defined by claim 1 only after the examiner cited Gras.

There is nothing inherently wrong with limiting a claim to avoid prior art. And, in fact, applicants often find that they have claimed subject matter described in the prior art thereby necessitating a limiting amendment to a claim. As noted by In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976):

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable.

But, the subject matter of the claim, as amended, must have described in the specification, as filed. For example, an applicant may describe a genus and certain species. A description of a genus and certain species, however, may not entitle the applicant to a claim to a subgenus. In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972).

Applicants rely on the description of a Markush group of blocking agents to establish factually that their specification describes blocking agents which do not have a 2,2,6,6-tetramethyl piperidinyl group. But, the Markush would

also mean that numerous blocking agents other than those with a 2,2,6,6-tetramethyl piperidiny1 group likewise are not described. It was not until Gras was cited that applicants seem to have arrived at the "subgenus" now claimed, i.e., isocyanates blocked with any blocking agent other than one having a 2,2,6,6-tetramethyl piperidiny1 group. The appeal does not involve a case where an applicant describes and originally claims a plurality of species, some of which turn out to be in the prior art. An amendment to eliminate the species within the prior art may be appropriate. Compare In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). Each species may be regarded as a different invention and cancellation of one invention from a claim does not mean that the remaining inventions claimed are not described. Thus, if applicants elected to cancel one member of the Markush group of claim 4, we doubt it could be argued that the specification did not describe the remaining members of the Markush group.

C. Decision

The examiner's rejection of claims 1-5 over Cook or Konig in view of Uhrhan is reversed.

The examiner's rejection of claims 1-4 as failing to comply with the description requirement of the first paragraph

of 35 U.S.C. § 112 is affirmed as to claims 1 and 3 and is
reversed as to claims 2 and 4.

AFFIRMED-IN-PART and REVERSED-IN-PART

_____)	
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Administrative Patent Judge)	
)	
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